

Remarks/Arguments

In the Office Action mailed May 12, 2004, the Examiner reopened prosecution of the application in view of the Appeal Brief dated March 3, 2004. Reconsideration and allowance of all of the claims present in the application, i.e., claims 16-36, are respectfully requested in light of the following remarks.

In the Appeal Brief dated March 3, 2004, Applicant provided specific elements that were not taught or suggested by the previously cited references. The Examiner reopened prosecution and rejected all the claims based on two new references that again do not teach or suggest the very elements that Applicant emphasized in the Appeal Brief. The undersigned attempted to conduct a telephone interview with the Examiner to discuss this Office Action. However, the Examiner was away from the office. If, after considering the following remarks, the Examiner does not find that the claims are in condition for allowance, the undersigned requests that the Examiner call the undersigned to discuss this matter before Applicant is forced to go to appeal again.

Claim Rejections under 35 USC §102(e)

Claims 16-22 stand rejected under 35 USC §102(e) as being anticipated by Sansone (U. S. Patent No. 5,726,894). This rejection is respectfully traversed.

Again it appears that the Examiner does not understand the present invention. In the rejection of claim 16, the Examiner does not discuss, nor does Sansone '894 disclose the following elements of claim 16:

- a) a first database of mailer electronic addresses indexed by mailer identification codes;
- b) means for creating at a first postal authority a mail item file corresponding to the mailpiece; said mail item file including said mailer identification code and said value-added service request; or
- g) means for communicating said performance of said value-added service to said first postal authority using said first postal authority address, wherein said first postal authority determines a mailer electronic address using a mailer identification code associated with the mailpiece and communicates

performance of said value-added service to the mailer using the mailer electronic address.

Furthermore, as set forth above with regard to the 102(b) rejection, Sansone '894 does not teach or suggest the system that provides for a distribution of a mailpiece by a plurality of postal authorities, wherein value-added services data associated with a mailpiece includes addressing information for a return receipt from an intended mailpiece recipient for services performed by a final handling postal authority, but confirmation is communicated by a first postal authority to the original mailer because the identity of the mailer is disclosed only to the first postal authority and not to subsequent handling postal authorities. Thus, Sansone '894 does not disclose, teach or suggest the limitations of claim 16.

As support for his rejections, the Examiner restates claim 16 and refers to col. 5, line 25 to col. 6, line 65 in Sansone '894. This section of Sansone '894 is a description of Fig. 1 of Sansone '894 which is a schematic view of a postage metering system according to Sansone '894, including separate printing and accounting apparatus. The description explains how the random access memory is structured and information is stored therein. See col. 5, lines 28-36

The alphanumeric and graphic information stored for display and selection purposes preferably corresponds to a plurality of selectable postal processing services 40 for a sheet 17, including the services 40A-40K as hereinafter discussed, each of which includes a different one of a plurality of predetermined service values 42 assigned thereto, including the values 42A-42K, one or more of which may be a zero value.

The rest of the cited description refers to various specific postal services that can be stored in the memory. There is no description or suggestion in Sansone '894 how value added services would be processed by a plurality of postal authorities as claimed in claim 16.

Based on the foregoing, Sansone ('894) neither discloses nor suggests the present invention. For at least the above reasons, Applicant respectfully submits that claim 16 is allowable over Sansone et al ('894). Claims 17-22, which are dependent upon claim 16, are allowable on their own merits.

Claims 23-36 stand rejected under 35 USC §102(e) as being anticipated by Sansone (U. S. Patent No. 6,549,892). This rejection is respectfully traversed.

According to 706.02(f) >Rejection Under 35 U.S.C. 102(e) (emphasis added):

35 USC §102(e), in part, allows for certain prior art (i.e., U.S. patents, U.S. patent application publications and WIPO publications of international applications) to be applied against the claims as of its effective U.S. filing date. This provision of 35 USC §102 is mostly utilized when the publication or issue date is too recent for the reference to be applied under 35 USC §102(a) or (b). **In order to apply a reference under 35 USC §102(e), the inventive entity of the application must be different than that of the reference.** Note that, where there are joint inventors, only one inventor need be different for the inventive entities to be different and a rejection under 35 USC §102(e) is applicable even if there are some inventors in common between the application and the reference

Sansone '892 and the instant application are both assigned to Pitney Bowes Inc. The undersigned confirms that both are still owned by Pitney Bowes Inc., and that the inventive entity for Sansone '892 was and is the same as for the instant application. For this reason, this rejection is traversed.

Furthermore, contrary to the remarks in paragraph 4 of the Office Action, Sansone '892 does not teach or suggest the following as set forth in claim 23. A method for providing value-added services requested by a mailer and relating to the **handling of a mailpiece by a plurality of postal authorities** wherein the **final handling post:** receives a mail item, **scans the mail item to obtain** a digital image of the mail item and **an identifier for an initial handling post, transmits merged digital images** of recipients signature and the mail item **to the initial handling post.** Neither does Sansone '892 teach or suggest the following as set forth in claim 30. A method for providing value-added services requested by a mailer and relating to the **handling of a mailpiece by a plurality of postal authorities** wherein an **initial handling post:** receives electronically a transfer file representing confirmation of delivery of a mail item by a final handling post, **parses the transfer file to retrieve digital images of the mail item and a signature of a recipient confirming delivery of the mail item, and sends to the mailer confirmation of delivery of the mail item.** To the

contrary, Sansone '892 does not address the handling of a mailpiece by a plurality of postal authorities.

Sansone ('892) is directed to a method that enables the post to deliver letters, flats, post cards and packages (mail) addressed to a recipient name and unique code to be delivered directly to the recipient. Mail addressed to a name and a unique code would be captured by the post during the posts sortation process and rerouted to the delivery address of the unique code. In support of the rejection of claims 23 and 30, the Examiner refers to Figs. 6 and 7; col. 2, lines 20-33; col. 4, lines 20-36 and col. 8, line 22 through col. 9, line 9.

Figs. 6 and 7 show respectively a flow chart showing a request by the post for a postal address for a unique code and a flow chart showing a request by a mail recipient requesting a routing change for their unique code. Col. 2, lines 20-33 provide a summary of the invention disclosed in Sansone ('892).

The invention accomplishes the foregoing by: assigning a unique code to each recipient that specifically identifies the recipient, i.e., social security number, tax identification number, etc.; relating recipients code with recipients name and delivery address; relating recipients address changes with recipients name and unique code; permitting individuals or entities to add recipients unique code to the recipient mailing address; reading information on mail to capture the unique code when present, determining recipient's delivery address from recipients code and recipient's name.

Col. 4, lines 20-36, describes how mail is processed using scanners and sorters.

Mail that is able to be scanned and sorted by sorter 24 is sent to a delivery bar code sorter/code printer 25 or a carrier sequence bar code sorter/code printer 26. Sorters 25 and 26 sort the mail in the order that the mail is going to be delivered by postal carrier 27. Mail that canceller 22 determines is not optical character readable is sent to bar code sorter/code printer 28. Mail that canceller 22 obtains electronic images from and mail that reader 23 obtains electronic images from transfers the electronic images to remote bar code system 32. Bar code system 32 matches the look up zip code for the mail pieces from canceller 22 and merges them. System 32 electronically transmits the bar code information to sorter 28 where the bar code information is sprayed on the mail pieces. Mail that is able to be scanned and sorted by sorters 24 and 28 is sent to a delivery bar

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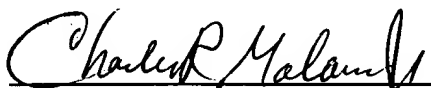
code sorter 25. Sorters 25 and 26 sort the mail in the order that the mail is going to be delivered by postal carrier 27.

Col. 8, line 22 through col. 9, line 9, describes how the invention of Sansone ('892) may be used in a corporate mail department. Sansone ('892) does not disclose or suggest the handling of a mailpiece by a plurality of postal authorities or the present invention.

Based on the foregoing, Sansone ('892) is not a proper 35 USC §102(e) reference and, furthermore, neither discloses nor suggests the present invention. For at least the above reasons, Applicant respectfully submits that claims 23 and 30 are allowable over Sansone et al ('892). Claims 24-29 and 31-36, which are dependent upon claims 23 and 30 respectively, are allowable on their own merits.

In view of the foregoing amendments and remarks, it is respectfully submitted that the claims of this application are now in a condition for allowance and favorable action thereon is requested.

Respectfully submitted,



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